

REMARKS

I. Status of the Application

Claims 1-21 are pending in this application. In the July 3, 2008 office action, the examiner:

- A. Rejected Claims 1, 4 and 5 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter;
- B. Rejected claim 4 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- C. Rejected claims 1-3 and 5-21 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,088,659 to Kelley et al. (hereinafter “Kelley”); and
- D. Rejected claim 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kelley.

In this response, applicants have amended claims 1, 4, 7 and 19 to correct typographical errors. Claim 4 has also been amended in order to render the examiner’s rejection under 35 U.S.C. § 112 moot. Applicants respectfully request reconsideration of pending claims 1-21 in view of the foregoing amendments and the following remarks.

II. The Rejection of Claims 1, 4 and 5 under 35 U.S.C. § 101 Should Be Withdrawn

In the July 3, 2008 Office action, the examiner rejected claims 1, 4 and 5 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicants

respectfully traverse the examiner's rejection of claims 1, 4 and 5 under 35 USC § 101, as the examiner has not made a prima face case of unpatentability under 35 U.S.C. § 101.

As set forth in MPEP § 2106.IV., the examiner should (i) determine whether the claimed invention falls within an enumerated statutory category (i.e., a process, machine, manufacture or composition of matter), and (ii) determine whether the claimed invention falls within a 35 U.S.C. § 101 judicial exception. The following passage from *Annex II of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* provides additional guidance with respect to processes:

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. § 101. **To be statutory, a claimed process must either: (A) result in a physical transformation** for which a practical application is either disclosed in the specification or would have been known to a skilled artisan, **or (B) be limited to a practical application which produces a useful, tangible, and concrete result.** See Diehr, 450 U.S. at 183-84, 209 USPQ at 6 (quoting Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) (“A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence.”). See also Alappat, 33 F.3d at 1543, 31 USPQ2d at 155657 (quoting Diehr, 450 U.S. at 192, [209 USPQ at 10]). See also id. at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) (“unpatentability of the principle does not defeat patentability of its practical applications”) (citing O'Reilly, 56 U.S. (15 How.) at 114-19).

1300 *Off. Gaz. Pat. Office* 142 (Nov. 22 2005) (emphasis added), as referenced by MPEP § 2106.

At page 2 of the July 3, 2008 Office action, the examiner rejected claims 1, 4 and 5, arguing that these claims “identify neither the apparatus performing the recited steps nor any transformation of underlying materials”. Thus, the examiner concluded that

claims 1, 4 and 5 are “directed to non-statutory subject matter”. However, the examiner completely failed to consider whether the claimed process is “limited to a practical application which produces a useful, tangible, and concrete result” as required by *Diehr* and referenced in the foregoing passage from *Annex II of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*. Accordingly, for at least this reason, the examiner has failed to make a prima facie case that claims 1, 4 and 5 of the present application are directed to non-statutory subject matter. Applicant submits the information in the paragraphs below for the examiner’s consideration with respect to a process having a useful, concrete and tangible result.

With respect to the “useful result” requirement, the USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP § 2106.IV.C.2.(2).

With respect to the “tangible result” requirement, a claim does not necessarily need to be tied to a particular machine or apparatus. Instead a claim must simply set forth a *practical application* in order to produce a tangible result. See MPEP § 2106.IV.C.2.(2).

With respect to the “concrete result” requirement, a “process must have a result that can be substantially repeatable or the process must substantially produce the same result again.” See MPEP § 2106.IV.C.2.(2).

Applicants respectfully submit that invention set forth in claims 1, 4 and 5 is specific, substantial and credible, and is therefore a process with a useful result. In addition, claims 1, 4 and 5 clearly set forth a practical application, and thus the claimed

process has a tangible result. Finally, the process set forth in claims 1, 4 and 5 is repeatable, and thus the claimed process has a concrete result.

As set forth above, the process claimed in claims 1, 4 and 5 has a useful, tangible and concrete result, and is thus a statutory process under 35 U.S.C. § 101. Should the examiner dispute this position, the examiner is required to establish a prima facie case that the claimed invention is not a statutory process with a useful, tangible and concrete result. See MPEP § 2106.IV.D. Since claims 1, 4 and 5 are directed to a process with a useful, concrete and tangible result, and since the examiner has not made a prima facie case to the contrary, it is respectfully submitted that the rejection of claims 1, 4 and 5 under 35 U.S.C. § 101 should be withdrawn.

III. The Rejection of Claim 4 Under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn

In the July 3, 2008 office action, the examiner rejected claim 4 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite because of the term “if necessary”. In this response, applicants have amended claim 4 to remove the term “if necessary”. Accordingly, the examiner’s rejection of claim 4 under 35 U.S.C. § 112, second paragraph, is now moot and should be withdrawn.

IV. The Rejection of Independent Claims 1, 7 and 14 Under 35 U.S.C. § 102(b) Should be Withdrawn

In the July 3, 2008 office action, the examiner rejected claims 1, 7 and 14 under 35 U.S.C. § 102(b) as allegedly being anticipated by Kelley. As provided in MPEP §

2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). In addition, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Kelley reference does not disclose all the limitations of claims 1, 7 and 14. For example, with respect to claim 1 the Kelley reference does not disclose “receiving information corresponding to a provider of the utility commodity and at least one entity that receives the utility commodity from the provider” and “forming a tree comprised of a root node and at least one leaf node emanating from the root node, the root node corresponding to the provider and the at least one leaf node corresponding to the at least one entity”. Furthermore, Kelley does not disclose any of the remaining limitations of claim 1 which are related to associating information with respective nodes.

In the July 3, 2008 Office action, the examiner argued that “forming a tree comprised of a root node and at least one leaf node emanating from the root node, the root node corresponding to the provider and the at least one leaf node corresponding to the at least one entity” is disclosed at col. 15, lines 18-24 of Kelley. However, a reading of this passage of Kelley simply discloses the existence of a cell directory service (CDS) for a Distributed Computing Environment (DCE). The DCE comprises a plurality of services as described at cols. 14 and 15 of Kelley. The primary purpose of the CDS in Kelley is to allow clients to locate servers. Accordingly, Kelley discloses that the CDS

implements a hierarchy of names arranged in a “tree structure” in which every item has exactly one parent and zero or more children. Although Kelley does disclose a “tree structure”, there is simply no disclosure that the tree structure is arranged with “a root node and at least one leaf node emanating from the root node, the root node corresponding to the provider and the at least one leaf node corresponding to the at least one entity” as set forth in claim 1. To the contrary, Kelley appears to suggest that the tree structure is provided to allow clients to locate servers. There is no suggestion that a root node of the tree corresponds to the provider and the leaf nodes correspond to entities that receive the utility commodity from the provider as required by claim 1. Accordingly, Kelley does not disclose all the limitations of claim 1 including the identical invention as set forth in claim 1 in as complete detail as is contained in the claim, as required by MPEP § 2131 in order to make a prima facie case of anticipation.

In addition to the foregoing, the other portions of Kelley cited by the examiner as showing the remaining limitations of claim 1 do not disclose the limitations the examiner proposes. For example, column 36, lines 39-49 discloses a graphical user interface capable of performing various activities related to meter management. However, there is no discussion in this or any other passages of Kelley of “associating a meter proxy with the at least one leaf node” as set forth in claim 1. In addition, column 37, lines 6-11 of Kelley disclose a server that assigns a unique client ID to each client and an AMR server that stores information including the requesting client’s ID. However, neither this passage nor any other passage of Kelley discloses the limitation of “associat[ing] at least some of the received information corresponding to the provider and the at least one entity with the root nodes node and the at least one leaf node, respectively”, as set forth in claim

1. Accordingly, Kelley does not disclose all the limitations of claim 1 including the identical invention as set forth in claim 1 in as complete detail as is contained in the claim, as required by MPEP § 2131 in order to make a prima facie case of anticipation.

Claims 7 and 14 include similar limitations to claim 1 with respect to the tree structure. Thus, for the same reasons as provided with respect to claim 1, Kelley does not disclose all the limitations of claims 7 and 14.

For at least the reasons discussed above, Kelley does not disclose all limitations of claims 1, 7 and 14 of the present application. Accordingly, it is respectfully submitted that claims 1, 7 and 14 are allowable and the examiner's rejection of claims 1, 7 and 14 as anticipated by Kelley under 35 U.S.C. § 102(b) should be withdrawn.

V. The Rejection of Dependent Claims 2-6, 8-13, and 15-21 Should Be Withdrawn

Dependent claims 2-6, 8-13, and 15-21 depend from and incorporate all the limitations of one of independent claims 1, 7, or 14. As set forth above, it is respectfully submitted that independent claims 1, 7 and 14 are allowable. Accordingly, it is also respectfully submitted that dependent claims 2-6, 8-13, and 15-21 are also allowable for at least the same reasons the independent claims 1, 7 and 14 are allowable.

VI. Conclusion

For all of the foregoing reasons, it is respectfully submitted the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application is therefore respectfully requested.

In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,



Russell E. Fowler II
Attorney Registration No. 43,615

Please address correspondence to:

Russell E. Fowler II
Maginot Moore & Beck
Chase Tower
111 Monument Circle, Suite 3250
Indianapolis, Indiana 46204-5115

Telephone: (317) 638-2922
Facsimile: (317) 638-2139
Email: refowler@maginot.com